

REMARKS

Reconsideration of the application as amended is respectfully requested. Claims 1-7 are unchanged and remain as originally filed. Claims 1-7 are considered allowable and patentably distinguishable over the prior art cited by the examiner for the reasons that follow. Claims 8-14 were previously canceled, and remain canceled in the present response.

New Claims 15-21 and 22-28 have been added and are also considered allowable and patentably distinguishable over the prior art cited by the examiner.

Claim 15 recites (quoted here for convenience):

15. A pet mastication article comprising:
a micro-porous body;
said body having a plurality of pores with diameters of between three microns and ten microns; and
an enriching agent impregnated into said body.

The references cited (Axelrod ('773 & '771) and Denesuk) fail to disclose every element of Claim 15. The references do not disclose a micro-porous body, the body having a plurality of pores with diameters ranging from three microns to ten microns. Nor do the references disclose a micro-porous body having the pores in the dimensions recited in which an enriching agent is impregnated into the body. No single reference or combination of references discloses the elements recited in Claim 15, thus Claim 15 is patentably distinguishable over the prior art cited. Furthermore, Claims 16-21 depend directly from Claim 15 and are also considered allowable and patentably distinguishable over the prior art cited.

Claim 22 recites (quoted here for convenience):

22. A pet mastication article comprising:
a micro-porous body;
said body having a plurality of pores with diameters of between three microns and ten microns; and
an enriching agent impregnated into said body, wherein said impregnation is accomplished via vacuum impregnation.

The references cited (Axelrod ('773 & '771) and Denesuk) fail to disclose every element of Claim 22. The references do not disclose a micro-porous body, the body having a plurality of pores with diameters ranging from three microns to ten microns. Nor do the references disclose a micro-porous body having the pores in the dimensions recited in which an enriching agent is impregnated into the body via *vacuum impregnation*. No single reference or combination of references discloses the elements recited in Claim 22, thus Claim 22 is patentably distinguishable over the prior art cited. Furthermore, Claims 23-28 depend directly from Claim 22 and are also considered allowable and patentably distinguishable over the prior art cited.

In undertaking to determine whether one reference anticipates the claim(s) of an application under 35 U.S.C. § 102(a), § 102(b) or § 102(e), a primary tenet is that the reference must teach every element of the claim(s). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Axelrod ('771) fails to anticipate Claims 1 and 3-7 of the present invention, therefore Claims 1 and 3-7 are patentably distinguishable over Axelrod ('771).

Claim 1 recites the following (quoted for convenience):

1. A pet mastication article comprising:
a micro-porous body;
an enriching agent impregnated into said body.

Axelrod ('771) fails to disclose a pet mastication article comprising a micro-porous body having an enriching agent impregnated therein as recited in claim 1. In particular, Axelrod ('771) discloses an extruded toy formed of solid thermoplastic with visible particles of animal meal suspended and dispersed throughout the thermoplastic. (Column 2, Lines 54-56, and FIG. 1). The disclosure of a solid thermoplastic material does not anticipate the micro-porous body disclosed in claim 1. For these reasons, Axelrod ('771) fails to disclose every element of claim 1 as required, thus claim 1 is patentably distinguishable over Axelrod ('771).

The examiner asserts that polyurethane (i.e. plastic) is inherently micro-porous. MPEP § 2112, II, requires "... that the subject matter is in fact inherent in the prior art reference. *Schering Corp. v. Geneva Pharm. Inc.*, 339 F.3d 1373, 1377, 67 USPQ2d 1664, 1668 (Fed. Cir. 2003)." There is no indication from the text of Axelrod ('771) that polyurethane is inherently micro-porous. The applicant is unaware of any source indicating that micro-porosity is an inherent quality of plastics, in general, or of polyurethanes, in particular. The applicant has an understanding that micro-porosity results from the choice of material used in the manufacturing process and/or the active use of a template or mold imparting micro-

porosity. Because Axelrod ('771) fails to indicate that polyurethane is inherently micro-porous, applicant is respectfully requesting additional support / evidence for this assertion. At present, however, the assertion of inherency is inappropriate.

Therefore, claim 1 is patentably distinguishable over Axelrod ('771). Because claims 3-7 depend directly or indirectly from claim 1, claims 3-7 are likewise patentably distinguishable over Axelrod ('771).

Denesuk fails to anticipate Claims 1-7 of the present invention, therefore Claims 1-7 are patentably distinguishable over Denesuk.

As noted previously, claim 1 recites a pet mastication article comprising a micro-porous body having an enriching agent impregnated therein. FIGS. 1, 2 and 4 and the abstract of Denesuk are cited as disclosing every element of claim 1. However, FIGS. 1, 2 and 4 are three separate embodiments of the Denesuk disclosure, wherein FIG. 1 depicts rawhide material, FIG. 2 depicts rope material and FIG. 4 depicts plastic material. Neither the referenced figures, the corresponding description, nor the abstract disclose a pet mastication article having a micro-porous body with an enriching agent impregnated within the body.

Therefore, claim 1 is patentably distinguishable over Denesuk. Claims 2-7 depend directly or indirectly from claim 1, therefore claims 2-7 are likewise patentably distinguishable over Denesuk.

Furthermore, in regard to claim 2, which recites that the body is a raw bone, Denesuk is cited as also disclosing that the body of the mastication article is a raw bone. However, column 4, line 58 discloses that the mastication article is rawhide, instead of raw bone. Therefore, Denesuk fails to disclose every

element of claim 2, thus claim 2 is patentably distinguishable over Denesuk.

Axelrod ('773) fails to anticipate Claims 1, 3 and 7 of the present invention, therefore Claims 1, 3 and 7 are patentably distinguishable over Axelrod ('773).

As in the citation of Axelrod ('771), the examiner also indicates that Axelrod ('773) discloses that polyurethane is inherently micro-porous. Axelrod ('733) fails to explicitly or implicitly (through inherency) disclose a micro-porous body having an enriching agent impregnated therein as recited in claim 1. In particular, Axelrod ('733) discloses a dog bone formed of a thermoplastic polyurethane resin. As indicated in Axelrod ('733), the formation of carbon dioxide gas during the manufacturing process, resulting from the exposure of isocyanate end groups reacting with moisture, results in "undesirable porosity", or a closed cell structure permitting only limited penetration of the agents, in the formation of the chewable object. (Column 3, Lines 46-51). The undesirability of porosity in Axelrod ('733) fails to anticipate the micro-porosity disclosed in claim 1. Thus, claim 1 is patentably distinguishable over Axelrod ('733). Because claims 3 and 7 depend directly or indirectly from claim 1, claims 3 and 7 are likewise patentably distinguishable over Axelrod ('733).

In undertaking a determination of whether a reference, or a combination of references, renders a claim(s) obvious under 35 U.S.C. § 103(a), the examiner must show that the reference or combination of references teach or suggest every element of the claim(s) in question. MPEP § 706.02(i).

The combination of Axelrod ('773) and Denesuk fails to disclose, teach, suggest or claim every element of claim 2 as required, thus claim 2 is patentably distinguishable over the combination cited.

The examiner concedes that Axelrod ('773) fails to disclose or teach a mastication article having a body formed from raw bone, and cites Denesuk FIGS. 1, 2 and 4 as teaching such an element. However, as indicated previously, FIG. 1 depicts rawhide material, FIG. 2 depicts rope material and FIG. 4 depicts plastic material. The figures referenced, and the corresponding description, fail to disclose the use of bone as the material for a masticating article as recited in claim 2. There is no reference in the text of Denesuk that discloses, teaches, suggests or claims such a use. As such, the combination of Axelrod ('773) and Denesuk fails to disclose, teach, suggest or claim every element of claim 2 as required, thus claim 2 is patentably distinguishable over the combination cited.

The combination of Axelrod ('771) and Denesuk fails to disclose, teach, suggest or claim every element of claim 2 as required, thus claim 2 is patentably distinguishable over the combination cited.

The examiner concedes that Axelrod ('771) fails to disclose or teach a mastication article having a body formed from raw bone, and cites Denesuk FIGS. 1, 2 and 4 as teaching such an element. However, as indicated previously, FIG. 1 depicts rawhide material, FIG. 2 depicts rope material and FIG. 4 depicts plastic material. The figures referenced, and the corresponding description, fail to disclose the use of bone as the material for a masticating article as recited in claim 2. There is no reference in the text of Denesuk that discloses, teaches, suggests or claims such a use. As such, the combination of Axelrod ('771) and Denesuk fails to disclose, teach, suggest or claim every element of claim 2 as required, thus claim 2 is patentably distinguishable over the combination cited.

The combination of Axelrod ('771) and ('733) fail to teach every element of claims 4-6. As

indicated by the examiner, Axelrod ('733) is entirely silent to the use of enriching agents. Axelrod ('771) discloses prior art that incorporates anti-microbial agents into the product. However, the prior art referenced (Boyer) discloses an oxide strip impregnated by such agents, in contrast to the solid thermoplastic material recited in Axelrod ('771). There is no motivation or suggestion of combining the teachings of Axelrod ('771) with the internally referenced art for the purpose claimed by the present invention, since the combination of Axelrod ('771) and the internal reference would defeat the intention of impregnating an article with an agent, having no means for egress until the solid thermoplastic material is pierced. Likewise, reference is made to an animal food product consisting of structure supporting fibers formed of collagen or cellulosic material containing dried meats, food additives, vitamins, minerals or medicinal supplements. However, the present invention claims the impregnation of vitamins and minerals into a micro-porous body, not of a body formed of collagen or cellulose. Thus, the combination further falls for failing to disclose the elements disclosed in claims 4-6.

Based upon the above arguments, it is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. § 103(a), in addition to any other art, relevant or not, is also inappropriate. However, by way of additional argument applicant wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. § 103(a), the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc.

et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). There is nothing in the prior art or the Examiners arguments that would suggest the desirability or obviousness of making a pet mastication article having a micro-porous body and an enriching agent impregnated into said body. Uniroyal, Inc. v. Rudkci-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (Fed. Cir. 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ 2d 1529 (Fed. Cir. 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (Fed. Cir. 1988).

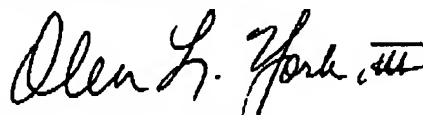
To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the

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pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (Fed. Cir. 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (Fed. Cir. 1988).

Therefore, in view of foregoing amendments and clarifications, the applicant submits that allowance of the present application and all remaining claims, as amended, is in order and a formal Notice of Allowance is respectfully requested at the earliest possible date.

Respectfully submitted,



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